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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LY, ANH

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/900,551	Applicant(s) CHASTAIN ET AL.	
	Examiner Anh Ly	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,13,15 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-12,14,16-23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is response to Applicants' AMENDMENT filed on 01/18/2006.
2. Claims 7 and 8 have been cancelled.
3. Claims 1-6, 9-12, 14, 16-23 and 25-27 are pending in this application.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-5, 9-12, 23 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,457,026 B1 issued to Graham et al. (hereinafter Graham) in view of Patent No.: 6,684,368 issued to Hull et al. (hereinafter Hull), and further in view of Patent No.: US 6,363,352 issued to Dailey et al. (hereinafter Dailey).

Art Unit: 2162

With respect to claim 1, Graham teaches a method in a data processing system for sharing text amongst a plurality of electronic books (displaying/selecting stored electronic document containing a plurality of pages with visual indications of the locations such as highlighting the text" figs. 2s', 3, 4 and 9's, col. 3, lines 18-67), the method comprising:

receiving a user input selecting the text from the electronic book to form selected text, wherein the text is at least one of (i) a noted passage text in the electronic book and (ii) a highlight passage of text in the electronic book (using the mouse as input device for receiving the text from electronic document or e-book to form a selected text by highlighted or annotated text in an electronically stored document or electronic book and the selected text after the e-book is displayed (fig. 1, item 36 or 30, fig. 2's item 220 and 224, col. 3, lines 56-67 and col. 4, lines 1-8); and

automatically sending the selected to each electronic document (fig. 8, the selected is automatically send to another user on the system: abstract, col. 6, lines 60-67 and col. 7, lines 1-5).

Graham teaches a method for highlighted or annotated text of stored electronic document or e-book, which contains plurality of pages including table of contents, receiving a user input via input device such as mouse or keyboard and highlighting the selected text after the e-book is displayed. Graham does not clearly teach a designated set of recipients in response to receiving the user input selecting the text.

However, Hull teaches a method for automatically specifying delivery information and displaying a plurality of potential recipients to a user (abstract, col. 1, lines 60-67).

Art Unit: 2162

Therefore, based on Graham in view of Hull, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Graham and Hull, because using the steps of "each electronic book for a designated set of recipients in response to receiving the user input selecting the text" would have given those skilled in the art to have ability to use GUI for assisting a user with tasks of organizing and distributing electronic documents. This gives users the advantage of processing and displaying of the plurality of recipients to a user and incorporating the electronic copy of the document into a database belonging to each of the plurality of selected recipients more efficiently. Graham and Hull do not teach each thereby share the text amongst the plurality of electronic books.

However, Dailey teaches sharing electronic documents for collaborative editing in the virtual meeting (abstract, fig. 9B, col. 2, lines 18-30, col. 3, lines 60-67 and col. 4, lines 1-16).

Therefore, based on Graham in view of Hull, and further in view of Dailey, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Dailey to the system of Graham for sharing the plurality of electronic books in the virtual meeting for editing (fig. 9B). Because using the steps of "share the text amongst the plurality of electronic books" would have given those skilled in the art the means for automatically scheduling and forming a virtual meeting for collaborative editing by the meeting attendees using a computer network. The motivation being for the purpose of automatically distributed the information to all

Art Unit: 2162

the user in the communication network, thereby, automatic sharing of information is provided more efficient.

With respect to claim 2, Graham teaches a method in a data processing system as discussed in claim 1.

Graham teaches a method for highlighted or annotated text of stored electronic document or e-book, which contains plurality of pages including table of contents, receiving a user input via input device such as mouse or keyboard and highlighting the selected text after the e-book is displayed. Graham does not clearly teach displaying a list wherein the designated set of recipients is selected from the list.

However, Hull teaches a method for automatically specifying delivery information and displaying a plurality of potential recipients to a user (abstract, col. 1, lines 60-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Graham with the teachings of Hull. One having ordinary skill in the art would have found it motivated to utilize the use of a designated set of recipients in response to receiving the user input selecting the text as disclosed (Hull's abstract, col. 1, lines 60-67), into the system of Graham for the purpose of processing and displaying of the plurality of recipients to a user and incorporating the electronic copy of the document into a database belonging to each of the plurality of selected recipients (Hull's col. 4, lines 38-56). The motivation being for the purpose of automatically distributed the information to all the user in the communication network, thereby, automatic sharing of information is provided more efficient.

With respect to claim 3, Graham teaches wherein the selected is highlighted text (col. 3, lines 56-65).

With respect to claim 4, Graham teaches wherein the highlighted text in a different color from unselected, bolded text, and text with a different font type from unselected text (col. 3, lines 56-67).

With respect to claim 5, Graham teaches storing the highlighted text in a data structure (in the user profile data structure: col. 5, lines 13-16).

With respect to claim 9, Graham teaches wherein the sending step sends the highlighted text to the designated set of recipients using a communications link (figs 5 and 6A).

With respect to claim 10, Graham teaches wherein the sending step sends the selected text to the designated set of recipients in an electronic mail message (document in electronic form, fig. 5 and col. 4, lines 45-56).

With respect to claim 11, Graham teaches wherein the selected text is located in a body of the electronic mail message (figs 2s', 6s' and 5).

With respect to claim 12, graham teaches wherein the selected text is located in an attachment attached to the electronic mail message (figs. 2s, document containing image file, and col. 4, lines 45-56).

Claim 23 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 26 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 27 is essentially the same as claim 1 except that it is directed to a computer program product in a computer readable medium rather than a method, and is rejected

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,457,026 B1 issued to Graham et al. (hereinafter Graham) in view of Patent No.: US 5,664,207 issued to Hull et al. (hereinafter Hull) and further in view of Patent No.: US 6,363,352 issued to Dailey et al. (hereinafter Dailey) and Pub. No.: US 20030206189 A1 of DeMello et al. (hereinafter DeMello).

With respect to claim 8, Graham in view of Hull and Dailey discloses a method for identifying topics as discussed in claim 1.

Graham, Hull and Dailey disclose substantially the invention as claimed.

Graham, Hull and Dailey do not teach wherein the data structure is a download file.

However, DeMello teaches download/upload document (section 0041).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Graham in view of Hull and Dailey with the teachings of DeMello by incorporating the use of downloading the

Art Unit: 2162

file. One having ordinary skill in the art would have found it motivated to utilize the use of a designated set of recipients in response to receiving the user input selecting the text as disclosed (Hull's abstract, col. 1, lines 60-67), into the system of Graham for the purpose of processing and displaying of the plurality of recipients to a user and incorporating the electronic copy of the document into a database belonging to each of the plurality of selected recipients (Hull's col. 4, lines 38-56). The motivation being for the purpose of automatically distributed the information to all the user in the communication network, thereby, automatic sharing of information is provided more efficient.

8. Claims 14, 16-22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,457,026 B1 issued to Graham et al. (hereinafter Graham) in view of Pub. No.: US 2004/0199529 A1 of Clark et al. (hereinafter Clark).

With respect to claim 14, Graham teaches a method in a data processing system for sharing text in an electronic book (displaying/selecting stored electronic document containing a plurality of pages with visual indications of the locations such as highlighting the text" figs. 2s', 3, 4 and 9's, col. 3, lines 18-67);

receiving a first user input selecting the text from the electronic book through a communications link to the data processing system (using the mouse as input device for receiving the text from electronic document or e-book to form a selected text by highlighted the selected text after the e-book is displayed (fig. 1, item 36 or 30, fig. 2's

Art Unit: 2162

item 220 and 224, col. 3, lines 56-67 and col. 4, lines 1-8); responsive to user input and displaying the text (figs. 2s', 9s').

Graham teaches a method for highlighted or annotated text of stored electronic document or e-book, which contains plurality of pages including table of contents, receiving a user input via input device such as mouse or keyboard and highlighting the selected text after the e-book is displayed. Graham does not clearly teach sorting the selected text from the at least one remote electronic book using a selection criteria to form sorted text.

However, Clark teaches automatically organizing or sorting stored electronic message or document (abstract and sections 0002-0005).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Graham with the teachings of Clark. One having ordinary skill in the art would have found it motivated to utilize the use of organizing the stored electronic document and displaying the text as disclosed (Clark's sections 0002-0005), into the system of Graham for the purpose of automatically organizing the stored electronic document or electronic messages, thereby, searching the stored electronic document more efficient (Clark's section 0011 and 0015).

With respect to claims 16-17, Graham teaches a method in a data processing system for sharing text in an electronic book as discussed in claim 14.

Graham teaches a method for highlighted or annotated text of stored electronic document or e-book, which contains plurality of pages including table of contents,

Art Unit: 2162

receiving a user input via input device such as mouse or keyboard and highlighting the selected text after the e-book is displayed. Graham does not clearly teach wherein selection criteria are used to sort and group the selected text, and wherein the selection criteria includes at least one of popularity, name of a user originating text within the selected text, and subject matter of portions or text within the selected text.

However, Clark teaches a set of search criteria (sections 0012 and 0223).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Graham with the teachings of Clark. One having ordinary skill in the art would have found it motivated to utilize the use of selecting of search criteria for the stored electronic document and displaying the text as disclosed (Clark's sections 0011 and 0223), into the system of Graham for the purpose of automatically organizing the stored electronic document or electronic messages, thereby, searching the stored electronic document more efficient (Clark's section 0011 and 0015).

With respect to claim 18, Graham teaches wherein the selected text includes passages from at least one remote electronic book (user over the Internet (col. 4, lines 45-67)).

With respect to claim 19, Graham teaches wherein the selected text includes annotations made by a user (section 0209).

With respect to claim 20, Graham teaches wherein the selection criteria are received from a user input (fig. 1, using the mouse, item 36).

With respect to claim 21, Graham teaches wherein the selection criteria are received with the selected text (figs. 2A)..

With respect to claim 22, Graham teaches wherein the sorted text excludes a portion of the selected text (figs. 2s' and 9s').

Claim 25 is essentially the same as claim 14 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 14 hereinabove.

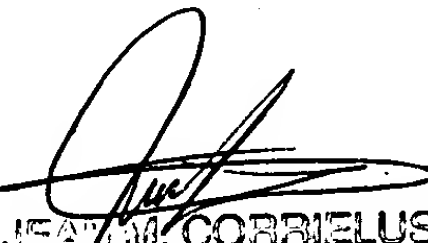
Contact Information


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV or fax to (571) 273-4039. The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107 or **Primary Examiner Jean Corrielus (571) 272-4032**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: **Central Fax Center (571) 273-8300**


JEAN M. CORRIELUS
PRIMARY EXAMINER

ANH LY 
MAR. 28th, 2006